REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-46 were in the application, claims 1, 18, 33 and 42-46 have been amended.

Previously mis-numbered claims 41-45, with a duplicate claim 41 have been renumbered as claims 41-46.

In response to the examiners request, another copy of EP 0909108 A2 is enclosed herewith.

Claims 1-3, 8-10, 12 and 13 were rejected under 35 USC 102(b) as being anticipated by Hamlin, EP 0928090.

To find anticipation, each and every element of the claim must be found in a single prior art reference. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220, U.S.P.Q. 303 (Fed. Cir. 1983). Also, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device. (Emphasis added) Shearing v. Iolab Corp., 975 F.2d 1541, 1544-45, 24 U.S.P.Q.2D (BNA) 1133, 1136 (Fed. Cir. 1992); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2D (BNA) 1913, 1920 (Fed. Cir 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 U.S.P.Q. (BNA) 669, 673 (Fed. Cir. 1984). C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir., 1998) Anticipation requires strict identity, without guessing what the reference discloses. Dayco Products, Inc. V. Total Containment Inc., 329 F.3d 1358 (Fed. Cir. 2003).

Claim 1 has been amended to clarify that the communication processing occurs within the communication routing apparatus. That is, the invention is directed to a router which is an independent way station on a network through which network data passes and by which it is directed. In the inventive communication routing apparatus, additional data processing means are available for conducting data conversion within the router. This is fairly unique, as most routers are passive devices, that is, they act invisibly within the network and do no more than facilitate the communication between devices. Here the inventive router actively conducts data conversions for transforming signals into selected forms.

In contrast, Hamlin describes data conversions that take place at the source and destination devices, that is, the router remains merely a thoroughfare for the data; processing

does not occur within the router as is accomplished according to the claimed invention.

Absent this element, within a communication routing apparatus, each and every element of amended claim 1 is not present in Hamlin, and claim 8, and the claims depending therefrom, are not anticipated by Hamlin.

Claims 4 and 5 were rejected as being obvious over Hamlin and further in view of Baudoin, U.S. Patent 5,406,557.

To support a holding of obviousness, there must be some teaching or suggestion for doing as the applicant has done. ACS Hospital Systems Inc. v. Montefiore Hospital, 723 F.2d 1572 (Fed. Cir. 1984). Further, it is not within the framework of 35 U.S.C. Section 103 to pick and choose from the prior art only so much as will support a holding of obviousness to the exclusion of other parts necessary for a full appreciation of what the prior art teaches or suggests, as hindsight is not the test. In re Wesslau, 353 F.2d 238 (CCPA 1965). Also, "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

As discussed above, Hamlin does not utilize internal processing means for conversion of data as does the present invention. Failing to include such processing means, there is clearly no teaching or suggestion for storing processed data, since there is no such processed data in Hamlin. Baudoin discloses maintaining messages in a queue which only, at best, provides temporary storage of email messages, and nothing to teach or suggest the incorporation of such email storage means in the apparatus of Hamlin. Absent some teaching or suggestion supporting the combination, the combination is improper and claims 4 and 5 are not obvious over the cited patents.

Claims 6, 7 and 11 were rejected as being obvious over Hamlin in view of Pasetes, U.S. patent 5,202,977.

As discussed above, Hamlin does not utilize internal processing means for conversion of data within the routing device itself as does the present invention. Failing to include such processing means, there is clearly no teaching or suggestion for storing processed data, since there is no such processed data in Hamlin. Pasetes discloses a microcomputer based system, similar to Hamlin, in that routing is separated from the processing of the information transmitted. Pasetes primarily discloses a processing language for performing translation of electronic

documents.

> "The system is organized into four component work centers: a) Communications Interface (having a communication session as its input work unit); b) De-enveloping (having an interchange as its input work unit); c) Translation (having a document as its input work unit); and d) Enveloping (having an enveloping request as its input work unit).
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> The communications interface work center uses a script to schedule a communication session and describe how to break up the contents of the communication into units of de-enveloping work.
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> The de-enveloping work center divides a communication interchange into its component documents. It also performs a routing function, routing documents to the required destination.
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> The translation work center manipulates an incoming document into the format that is expected by another system. It can convert EDI data to a format that can be printed or used by application programs and can convert a file created by an application program to a standard EDI format. It is implemented as an interpreter or compiler that understands translation primitives and can be used with a script to perform transformations on many kinds of data. In the illustrated embodiment, each of these work centers are implemented using a novel EDI programming language, referred to herein as the e-language.

The system is not centralized for performing processing internally within a router, but rather the functions are distributed and handled by different elements connected to the system. There certainly is nothing to teach or suggest the incorporation of the EDI programming language in the apparatus of Hamlin, and even with this combination, nothing to teach or suggest the processing of data within a communication routing apparatus. At best it might be considered "obvious to try" to utilize the particular work centers referenced by Pasetes, such as the enveloping and de-enveloping work centers, considered to be required by Pasetes to perform the translations and transmissions discussed. However, such work centers are not utilized in the applicants' invention, leading one away from the present invention. Absent some teaching or suggestion for doing as the applicant has done, claims 6, 7 and 11 are not obvious over the cited patents.

Claims 14 and 15 were rejected under 35 USC 103(a) as being obvious over Hamlin as applied to claim 1, and further in view of Coleman, U.S. patent no. 5,708,828.

To establish a prima facie case of obviousness based on a combination of references, there must be some teaching, suggestion or motivation in the prior art to make the specific

combination that was made by the applicant. In re Raynes, 7 F.3d 1037, 1039, 28 U.S.P.Q.2D (BNA) 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D (BNA) 1443, 1445 (Fed. Cir. 1992). Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991). As discussed in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

Given a fair and unbiased reading of the cited art, one skilled in the art could find no teaching or suggestion of the applicants' claimed invention, while a fair reading of the Examiners' comments illustrates a clear case of a hindsight reconstruction. As the Court outlined in In re Fine:

"The Examiner relies on hindsight in reaching his obviousness determination. But the court has said, 'To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.' W.L. Gore, 721 F. 2d at 1553, 220 USPQ at 312-13. It is essential that the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made...to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art. Id. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. In re Fine F. 2d 1071, 1075 (Fed. Cir. 1988).

The examiner in this instance is picking and choosing various element from the cited prior art, without any teaching or suggestion present in the references for doing so. In other words, the examiner is using impermissible hindsight to reject these claims. In particular, Coleman is a data conversion system usable on a single computer; no router is even mentioned, and there is nothing to teach or suggest use in a communication routing apparatus:

"As shown in FIG. 1, the computer system 22 executing the data conversion

system and method of the present invention first receives input data from a user regarding the formats of the input and output data. The present invention then accesses the data in the first data format on the first storage medium 24 and provides the converted data to the second storage medium 26, wherein the converted output data has the second data format. FIG. 1 is an illustrative example only and shows conversion from a mainframe computer system 24 to a PC-based system 26. However, it is noted that the data conversion system and method of the present invention may be used when converting data from many of various storage mediums having any of various data formats to any of various output storage mediums also having any of various data formats. It is also noted that the first and second storage mediums may be the same medium, i.e., the data conversion system and method executing on the computer 22 can read data from the storage medium 24, convert the data to a new format, and then output the converted data back to the same medium, i.e., the medium 24, as shown by the dotted line between the computer 22 and the computer 24.

In one embodiment of the invention, a user enters various information into the computer 22 and then executes the data conversion system and method to perform the data conversion. In an alternate embodiment, one or more users may be at various remote locations from the computer 22 and can access the computer 22 via Internet or TCP/IP connections to access the data conversion system and method executing on the computer system 22. Also, it is noted that the computer systems 22 and 26 may be the same computer system."(emphasis added)

Given the above, absent a teaching or suggestion supporting the combination claims 14 and 15 are not rendered obvious over the proposed combination.

Claim 17 was rejected as being obvious over Hamlin in view of Hughes-Hartog, U.S. patent 5,495,485.

As discussed above relative to claims 6, 7 and 11, Hamlin does not utilize internal processing means for conversion of data as does the present invention. Failing to include such processing means, there is clearly no teaching or suggestion for processing a signal in a layer of an OSI networking reference model, since there is no such processed data in Hamlin. Absent a teaching or suggestion within the primary reference for performing such data processing, it is improper to combine the primary reference with Hughes-Hartog, and this rejection should be withdrawn.

Claims 18-20, 23-30, 33-35, and 38-43 were rejected as being obvious over Hamlin in view of Pasetes, U.S. patent 5,202,977.

As discussed above relative to claims 6, 7 and 11, Hamlin does not utilize internal

processing means for conversion of data as does the present invention. Failing to include such processing means, there is clearly no teaching or suggestion for processing input invoice data and converting this to a different invoice form, since there is no such processed data in Hamlin. Pasetes discloses a microcomputer based system, similar to Hamlin, in that routing is separated from the processing of the information transmitted. Pasetes discloses a processing language for performing translation of electronic documents.

"The system is organized into four component work centers: a) Communications Interface (having a communication session as its input work unit); b) De-enveloping (having an interchange as its input work unit); c) Translation (having a document as its input work unit); and d) Enveloping (having an enveloping request as its input work unit).

The system is not centralized within a router for performing processing of invoice data internally within the router, but rather the functions are distributed and handled by different elements connected to the system. There certainly is nothing to teach or suggest the incorporation of the EDI programming language in the apparatus of Hamlin, and even with this combination, nothing to teach or suggest the processing of invoice data within a communication routing apparatus. At best it might be considered "obvious to try" to utilize the particular work centers referenced by Pasetes, such as the enveloping and de-enveloping work centers, considered to be required by Pasetes to perform the translations and transmissions discussed. However, such work centers are not utilized in the applicants' invention, nor is the "e language" and absent some teaching or suggestion for doing as the applicant has done, claims 18-20, 23-30, 33-35, and 38-43 are not obvious over the cited patents.

Claims 21, 22, 36 and 37 were rejected as being obvious over Hamlin and Pasetes as applied to claims 18 and 33 above, and further in view of Baudoin.

As discussed above, these references discuss distributed functions performed typically by the sending computer, or a receiving computer or by a microprocessor device attached to a network. None of the cited references teach or suggest having a communications router that can perform the conversion of invoice forms internally during the normal transmission process, that is, at an independent way station located between the transmitter and the receiver. Certainly, giver the perceived complexity evidenced by the cited systems, it would be unobvious for this function to be performed by a communication routing device, and claims 21, 22, 36 and 37 are

clearly not obvious over the cited references.

Claims 31, 32, 44(now 45) and 45 (now 46) were rejected as being obvious over Hamlin and Pasetes as applied to claims 18 and 33, and further in view of Coleman.

As discussed above, these references discuss distributed functions performed typically by the sending computer, or a receiving computer or by a microprocessor device attached to a network. In Coleman, the processing can be performed on a single computer, that is, data is converted from one form to another, with no routing at all. None of the cited references teach or suggest having a communications router that can perform the conversion of invoice forms internally during the normal transmission process, that is, at an independent way station located between the transmitter and the receiver. Certainly, given the perceived complexity evidenced by the cited systems, it would be unobvious for this function to be performed by a communication routing device, and claims 31, 32, 45 and 46 are clearly not obvious over the cited references.

Based on the above amendment and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

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